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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,808	05/22/2001	Yijun Deng	ORT-1432	1171

27777 7590 12/24/2002  
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EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 12/24/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/862,808

Applicant(s)

DENG ET AL.

Examiner

Rebecca L Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 4-20 and 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-3, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-30 are currently pending in the instant application. Claims 4-20 and 23-30 are withdrawn as being for a non-elected invention. Claims 1-3, 21 and 22.

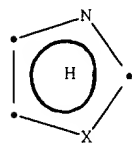
### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-3, 21 and 22 and the election of the species of Example 1 (page 25 of the specification) in Paper No. 8 is acknowledged. The traversal is on the ground(s) that no serious burden is placed upon the examiner (according to MPEP 803) if examiner were to examine the entire application (all 30 claims) and furthermore cites as an example, the examination of groups I and II as the difference is only the Z substituent. This is not found persuasive because the inventions are independent and distinct because there is no patentable co-action between the groups and a reference anticipating one member will not render another obvious. Each group is directed to art recognized divergent subject matter, and the groups themselves are inclusive of patentably distinct subject matter, which requires different searching strategies for each group. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner. The requirement is still deemed proper and is therefore made FINAL.

With the identification of the above noted species, the examiner will identify a generic concept, inclusive of said species, for examination.

The generic concept is that of the method of synthesizing highly substituted azole compounds having the formula (Ia) wherein:

**X** is selected from the group consisting of NH and  $\text{NR}^{\text{A}}$  wherein  $\text{R}^{\text{A}}$  is selected from the group consisting of hydrogen and  $-\text{R}$ , wherein  $-\text{R}$  is aralkyl;



represents a 5 membered aromatic ring structure containing no additional heteroatoms, optionally substituted with one to three substituents independently selected from the group consisting of halogen, hydroxy, alkyl, halogenated alkyl, alkenyl, cycloalkyl, alkoxy, aryl, aralkyl, amino, mono-or di-substituted amino, cyano, nitro,  $-\text{COOR}$ ,  $-\text{COR}$ ,  $\text{SO}_2\text{R}$  and  $\text{CONR}^{\text{B}}\text{R}^{\text{C}}$ , wherein the amine substituents are independently selected from alkyl, cycloalkyl, aryl or aralkyl, wherein the cycloalkyl or aryl may be further optionally substituted with one or more substituents selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

**Z** is  $\text{OR}^{\text{A}}$  wherein  $\text{R}^{\text{A}}$  is  $-\text{CONR}^{\text{C}}\text{R}^{\text{D}}$ ;

**R<sup>3</sup>** is selected from the group consisting of hydrogen, alkyl, aralkyl, cycloalkyl, and fluorinated alkyl, wherein the aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

**R<sup>4</sup>** is selected from the group consisting of alkyl, aryl, aralkyl, cycloalkyl, fluorinated alkyl, alkenyl and alkynyl, wherein the alkyl, alkenyl, alkynyl, aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, aryl, amino, mono-or di-substituted amino, cyano or nitro;

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**R** is selected from the group consisting of alkyl, aryl, aralkyl, cycloalkyl and fluorinated alkyl, wherein the aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

**R<sup>A</sup>** is independently selected from hydrogen, -R, -COOR, COR and CONR<sup>C</sup>R<sup>D</sup>;

**R<sup>B</sup>** is independently selected from the group consisting of hydrogen, -R, COOR, -COR, SO<sub>2</sub>R, SOR and -CONR<sup>C</sup>R<sup>D</sup>; and

**R<sup>C</sup>** and **R<sup>D</sup>** are independently selected from the group consisting of hydrogen, alkyl, aryl, aralkyl, cycloalkyl and fluorinated alkyl, wherein the aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro.

The remaining subject matter of claims 1-3, 21 and 22 and the subject matter of claims 4-20 and 23-30 stands withdrawn, 37 CFR 1.142(b), as being for non-elected inventions. The withdrawn subject matter of the claims is properly restricted as said subject matter differs materially in structure and element from the elected subject matter so as to be patentably distinct, i.e. a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter. Additionally, the fields of search are not co-extensive.

Accordingly, the claims are drawn to more than a single invention and restriction as has been required is proper, 37 CFR 1.142(a).

### ***Claim Objections***

Claims 1-3, 21 and 22 are objected to as containing non-elected subject matter. The claims presented drawn solely to the elected subject matter as indicated supra would appear allowable.


### **Conclusion**


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.

  
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